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10/561,590

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EXAMINER

KRAUSE, ANDREW E

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,590	Applicant(s) TROPLIN ET AL.	
	Examiner ANDREW KRAUSE	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/20/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I in the reply filed on 1/5/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. However, upon reconsideration of the restriction requirement, claims 1-16 have been examined, and the restriction requirement withdrawn.

Specification

3. The examiner acknowledges that where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "cocoa taste enhancer" in claims 2-14 is used by the claim to mean "a water soluble cocoa extract" (as set forth in [0021] of the PGPUB of the instant application), while the generally accepted meaning is "a product such as sugar or salt that is known to improve the taste properties of cocoa."

Claim Objections

4. Claims 3, 8 and 16 are objected to because of the following informalities:

'105' should be changed to 10⁵. Appropriate correction is required.

5. Claim 5 is objected to because of the following informalities: '4' in line 2, should be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14-16 provide for the use of a concentrate or coffee machine, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

8. Claims 14-16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

9. Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. The amount of concentrate capable of being solubilized by a maximum of 90 g of water is not given; therefore the scope of the claim is not ascertainable.

10. Claims 4 and 9 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. There are no units given for the density range claimed, therefore the scope of the claim is not ascertainable.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
14. **Claims 1 and 15 are** rejected under 35 U.S.C. 103(a) as being unpatentable over Tinsley et al (EP 0449553 A1).
15. Tinsley discloses a process for producing a chocolate drink comprising the steps of:
 - a. Inserting a capsule containing a concentrate of the chocolate drink into a coffee machine operating under percolation under pressure (column 3 lines 29-42, column 4, lines 29-36);
 - b. Injecting water (column 3 lines 29-42, column 4, lines 29-36); and

- c. Recovering the chocolate drink (column 3 lines 29-42, column 4, lines 29-36).

16. Although Tinsley does not explicitly disclose the concentration of cocoa in the beverage, it would have been obvious to one having ordinary skill in the art to adjust the cocoa concentration (for example by using more or less water or cocoa concentrate) to adjust the flavor for the intended purpose, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

17. **Regarding claim 15**, in light of the above rejection to claim 1, Tinsley therefore discloses using a coffee machine operating by percolation under pressure for the manufacture of a chocolate drink containing at least 2 percent cocoa.

18. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tinsley et al (EP 0449553 A1) as applied to claim 15, in further view of Halliday, US 2003/0033938 A1).

19. Tinsley discloses the use of the coffee machine in claim 15, but fails to disclose using the pressure claimed. However, Halliday discloses that espresso type machines often operate at pressures of 6×10^5 Pa or greater [0002]. It would have been obvious to one having ordinary skill in the art at the time of the invention to use the coffee machine to produce a cocoa beverage like the one disclosed by Tinsley using a higher pressure as

disclosed by Halliday, as producing the beverage under a higher pressure incorporates gases into the beverage and creates a desirable foamed texture and appearance ([0007]).

20. **Claims 2,3,4 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tinsley et al (EP 0449553 A1) in view of Fox (US #2,977,231) and Durrenmatt (US #2,380,158).

21. Tinsley discloses the process of claim 1, but fails to explicitly disclose the composition of the beverage concentrate.

22. However Fox discloses a beverage concentrate for producing a chocolate beverage comprising cocoa powder (Example 2).

23. It would have been obvious to one having ordinary skill in the art to combine the process of Tinsley with the use of a cocoa powder containing beverage concentrate like the one disclosed by Fox, because such a concentrate contains a higher cocoa content than conventional syrups and is capable of easily dissolving in liquid (column 2, lines 1-14).

24. Tinsley and Fox fail to explicitly disclose incorporating a cocoa taste enhancer into the concentrate. However Durrenmatt discloses a water soluble cocoa extract (cocoa taste enhancer), which can be incorporated into foods and ice cream mixes (column 1, lines 6-22). It would have been obvious to one having ordinary skill in the art to combine the process of Tinsley and Fox with the addition of a cocoa taste

enhancer as disclosed by Durrenmatt because such a taste enhancer incorporates highly soluble and sediment free (column 1, lines 1—15) flavor containing all cocoa flavorings except for fat (column 2, lines 27-36).

25. **Regarding claim 3**, the concentrate disclosed by Fox is 63.25 Brix (Example 1), which is 63.25% solids on a weight basis. The addition of a cocoa extract like the one disclosed in Durrenmatt will slightly increase said solids percentage.

26. In response to the limitation 'completely solubilized by the passage, at a temperature of 60-70 C and at a maximum pressure of 6×10^5 Pa, of a maximum 90 g of water', a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

27. Additionally, the process of Tinsley calls for passing water at a pressure of 10^5 Pa (column 2, lines 36-45). Further, the concentrate of Fox is completely solubilized in liquids of seemingly cooler (as milk is also disclosed as a liquid) temperatures (column 1, lines 65-71), therefore it would also be solubilized at the higher temperature, since solubility increases with temperature. The temperature could further be adjusted to achieve the desired mouthfeel of the drink for the intended purpose, since it has been

held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

28. **Regarding claim 4**, given the unitless nature of the density range in the claim, and the fact that for most liquids density and specific gravity are similar values, the specific gravity of 1.306 (example 2) disclosed for the syrup of Fox is considered to meet the claim.

29. **Regarding claim 6**, the concentrate of Fox is in liquid form (column 1, line 72-column 2, line 15 (syrup), example 2)

30. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tinsley et al (EP 0449553 A1) in view of Fox (US #2,977,231) and Durrenmatt (US #2,380,158) as applied to claim 3 above, in further view of Smith (US # 3,385,714).

31. Tinsley, Fox, and Durrenmatt disclose the process of claim 3, but fail to disclose using a concentrate with the claimed viscosity. However, Smith discloses the incorporation of colloidal seaweed extracts and vegetable gums to chocolate based drink mixes as a means of controlling the viscosity of the beverage (column 1, line 70-column 2, line 15). It would have been obvious to one having ordinary skill in the art to increase the viscosity of the concentrate disclosed in Fox, Tinsley and Durrenmatt by adding a viscosity control agent as disclosed by Smith, as increasing the viscosity of the

concentrate will allow for a thicker and more desirable texture to the final product, rather than a watery one (column 1, lines 30-40).

32. Further, given the teachings of Tinsley, Fox, Durrenmatt, and Smith, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the viscosity of the drink concentrate in order to achieve the texture desired in the drink concentrate (and therefore the beverages produced from it) for the intended application, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

33. **Claims 7-9,11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US #2,977,231) in view of Durrenmatt (US #2,380,158).

34. **Regarding claim 7**, Fox discloses a beverage concentrate containing cocoa powder (Example 2), but fails to disclose the addition of a cocoa taste enhancer. However Durrenmatt discloses a water soluble cocoa extract (cocoa taste enhancer), which can be incorporated into foods and ice cream mixes (column 1, lines 6-22). It would have been obvious to one having ordinary skill in the art to combine the product Fox with the addition of a cocoa taste enhancer as disclosed by Durrenmatt because such a taste enhancer incorporates highly soluble and sediment free (column 1, lines 1—15) flavor containing all cocoa flavorings except for fat (column 2, lines 27-36).

35. **Regarding claim 8**, the concentrate disclosed by Fox is 63.25 Brix (Example 1), which is 63.25% solids on a weight basis. The addition of a cocoa extract like the one disclosed in Durrenmatt will slightly increase said solids percentage.

36. In response to the limitation 'completely solubilized by the passage, at a temperature of 60-70 C and at a maximum pressure of 6×10^5 Pa, of a maximum 90 g of water', a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

37. Further, the concentrate of Fox is completely solubilized in liquids of seemingly cooler (as milk is also disclosed as a liquid) temperatures (column 1, lines 65-71) at atmospheric pressure, therefore it would be solubilized at the higher temperature, since solubility increases with temperature.

38. **Regarding claim 9**, given the unitless nature of the density range in the claim, and the fact that for most liquids density and specific gravity are similar values, the specific gravity of 1.306 (example 2) disclosed for the syrup of Fox is considered to meet the claim.

39. **Regarding claim 11**, the concentrate of Fox is a syrup, thereby in liquid form (column 1, line 72-column 2, line 15, example 2).

40. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US #2,977,231) in view of Durrenmatt (US #2,380,158) as applied to claim 8, in further view of Smith (US # 3,385,714).

41. Fox and Durrenmatt disclose the product of claim 8, but fail to disclose using a concentrate with the claimed viscosity. However, However, Smith discloses the incorporation of colloidal seaweed extracts and vegetable gums to chocolate based drink mixes as a means of controlling the viscosity of the beverage (column 1, line 70-column 2, line 15). It would have been obvious to one having ordinary skill in the art to increase the viscosity of the concentrate disclosed in Fox and Durrenmatt by adding a viscosity control agent as disclosed by Smith, as increasing the viscosity of the concentrate will allow for a thicker and more desirable texture to the final product, rather than a watery one (column 1, lines 30-40).

42. Further, given the teachings of Fox, Durrenmatt, and Smith, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the viscosity of the drink concentrate in order to achieve the texture desired in the drink concentrate (and therefore the beverages produced from it) for the intended application, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

43. **Claims 12 and 13 are** rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US #2,977,231) in view of Durrenmatt (US #2,380,158) as applied to claim 7, in further view of Tinsley (EP 0449544 A1).

44. Fox and Durrenmatt disclose the product of claim 7, but fail to disclose that it is incorporated into a coffee machine operating by percolation under pressure.

45. However, Tinsley discloses a capsule for use in a coffee machine that operates by percolation under pressure which contains a liquid chocolate concentrate (column 1, lines 6-16, column 2, lines 6-11, column 4, lines 20-36).

46. It would have been obvious to one having ordinary skill in the art at the time of the invention to insert the chocolate concentrate of Fox and Durrenmatt into a capsule as disclosed by Tinsley, because the capsule of Tinsley is a package which improves the dissolution or slurring of liquid comestibles (column 2, lines 6-11).

47. **Regarding claim 13**, Tinsley fails to explicitly disclose the volume of the capsule; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the volume of the capsule based on the size and desired concentration of cocoa in the final beverage desired for the intended purpose, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 96/34535 is cited as an 'X' reference against claims 7 and 14, but was not applied as the product disclosed does not contain a cocoa taste enhancer as defined by the instant specification. EP 1 190 959 is cited as an 'X' reference against claim 1, but was not cited as the copy provided is in French.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KRAUSE whose telephone number is (571)270-7094. The examiner can normally be reached on 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ANDREW KRAUSE/
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